

REMARKS

Applicants have carefully reviewed this Application in light of the Office Action mailed February 9, 2006. In order to advance prosecution of this case, Applicants cancel Claim 12 without prejudice or disclaimer, and add new Claims 29-31. The amendments and cancellation to these claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicants' amendments have only been done in order to advance prosecution in this case. Applicants respectfully request reconsideration of the pending claims and favorable action in this case.

Section 103 Rejections

The Examiner rejects Claims 1-4, 6-8, 11-13, 16, 19-22, and 27-28 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,047,051 issued to Ginzboorg et al. (hereinafter "*Ginzboorg*") in view of U.S. Patent No. 6,389,537 issued to Davis et al. (hereinafter "*Davis*").

Relying once again on the well-settled principle that the Applicants need only show that the prior art references fail to teach a single element of the claimed invention, the Applicants maintain that *Ginzboorg* and *Davis* are inadequate to support the Examiner's rejections. The Examiner's comments in response to prior arguments have helped to focus the prosecution of this case, however, and the Applicants now hope to respond in kind.

Independent Claim 1

One aspect of novelty of the Applicants' claims may best be revealed by some of the advantages that the claimed invention provides over *Ginzboorg* and *Davis*. One such advantage is reflected in Independent Claim 1, the limitation reciting: "providing the content corresponding to the content request *under the control of the proxy* from the content server to the subscriber terminal." By controlling the delivery of content, the proxy is able to monitor the subscriber's usage without imposing any requirement for upgrades or modifications to the subscriber's terminal. In contrast, *Ginzboorg* clearly places the monitoring burden on each individual terminal that subscribes to a service. (*See Ginzboorg* at col. 3, lines 13-16 ("monitoring is done in the customer terminal").)

The Examiner cites column 6, lines 55-63 for the proposition that *Ginzboorg* teaches this element of the Applicants' claimed invention, but this passage makes only a passing reference to providing content and does not suggest that the "billing server" controls the content delivery. To the contrary, *Ginzboorg* states that "the billing server asks the service provider to start sending the information to the customer," which implies that the billing server does not participate at all in the content delivery. This implication is consistent with the other statements in *Ginzboorg* that place the monitoring burden on the customer terminal. Thus, *Ginzboorg* requires upgrades or changes to customer terminals, such as the user interface illustrated in FIGURE 4 of *Ginzboorg*, so that the customer terminals may monitor content delivery and interact with the billing server. Accordingly, *Ginzboorg* fails to provide this advantage of the Applicants' claimed invention, and fails to teach or suggest the limitation of Independent Claim 1 that requires the proxy to control the content delivery.

#### Dependent Claim 2

Another significant advantage of the Applicants' claimed invention is that it avoids the need for any user agreement between the subscriber and the service provider. Rather, the Applicants' invention leverages existing agreements between the subscriber and an access network operator. In the novel architecture described by the Applicants, the content proxy need only have a relationship with the access network operator - not each subscriber. A unique, static subscriber identity [allocated by the access network operator to the subscriber] serves as the link between the content service proxy and the subscriber. This architecture facilitates content-based billing that is flexible for both the subscriber and the content service provider. This advantage of the Applicants' invention is reflected in Dependent Claim 2, which claims a subscriber terminal that is "located in an access network in which the subscriber terminal is addressed by an access network subscriber identity [and] determining in the proxy on the basis of [a] received IP address the subscriber identity . . . and using it to determine the billing address."

In contrast, *Ginzboorg* requires the billing service provider to make "long-term contracts with customers (those persons who use the services offered by the service providers)." (*Ginzboorg* at col. 5, lines 19-21.) The Examiner relies in part on this same statement for the proposition that *Ginzboorg* discloses a subscriber terminal that is addressed

by an access network subscriber identity, but as *Ginzboorg* implies in the next sentence, the “unique customer identifier” is not provided by an access network operator - it is allocated by the billing service provider. This is an important distinction that the Examiner has overlooked. It is the subscriber’s agreement with the access network operator and the appurtenant subscriber identity that represents the subscriber’s freedom from long-term contracts with the content service proxy operator. Accordingly, *Ginzboorg* fails to provide this additional advantage of the Applicants’ claimed invention, and fails to teach or suggest the limitation of Dependent Claim 2, “wherein the subscriber terminal is located in an access network in which the subscriber terminal is addressed by an access network subscriber identity.” *Ipso facto*, *Ginzboorg* further fails to teach or suggest the limitation of Dependent Claim 2 of determining the subscriber identity of the subscriber terminal based on an IP address allocated to the subscriber identity and using it to determine the appropriate billing address. For at least these reasons, which may be particular to only this claim and Dependent Claim 2 is allowable over the proposed combination of references.

Dependent Claims 2-11, 13-22, 24-25, and 27-28

The Examiner rejects Claims 2-11, 13-22, 24-25, and 27-28 under 35 U.S.C. §103(a), citing various references in support thereof. These claims, however, depend on Independent Claim 1 and are patentable for the same or analogous reasons for which that claim is patentable. The Applicants respectfully request reconsideration and withdrawal of these rejections for the reasons set forth above.

New Claims 29-31

The Applicants add new Claims 29-31, which recite limitations analogous to those discussed above in the context of Claims 1 and 2. Accordingly, Claims 29-31 are allowable for the same or for analogous reasons.

CONCLUSION

Applicants have now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicants respectfully request reconsideration and allowance of the pending claims.

Applicants believe no fee is due. However, if this is not correct, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicants invite the Examiner to contact Thomas J. Frame at 214.953.6675.

Respectfully submitted,  
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Customer No. **05073**